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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,618	12/18/2000	James M. Barton	60097-0195	9889
29989 7590 11/05/2007 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110			EXAMINER SHELEHEDA, JAMES R	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 11/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/740,618

Applicant(s)

BARTON, JAMES M.

Examiner

James Sheleheda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 14 and 16-36 is/are pending in the application.
- 4a) Of the above claim(s) 4, 17 and 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 14, 16, 18 and 32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. On pages 8-9, of applicant's response, applicant argues that Zigmond interrupts the video programming to create his own commercial breaks and does not disclose designating a beginning portion of a commercial break in a program segment.

a. In response, Zigmond discloses wherein the system will determine an appropriate time within the video stream to insert advertisements and then interrupt the video programming to output the ads (column 16, lines 30-44). Thus, Zigmond's system clearly discloses identifying and marking (or ***designating***) where a commercial break will occur in the program segment, as the advertisement system *designates* a particular point within the program to create a commercial break.

Further, as Zigmond discloses wherein the beginning portion of the commercial break will consist of a menu indicating a plurality of advertisements to be selected (column 16, line 65-column 17, line 9), he clearly discloses designating a beginning portion of a commercial break.

Applicant's argument that "Zigmond does not pay attention to a beginning portion of a commercial break in a program segment since he creates his own opportunities to display advertisements" is not persuasive, as Zigmond's creation of the commercial break is a *designation* of the commercial break and its corresponding beginning portion. The claims do not require the system to "pay

attention to" commercial breaks within the program segment but to ***designate*** the commercial break. As Zigmond's system defines and creates the commercial break, he clearly meets the claim limitations.

b. On page 10, applicant argues that Zigmond's advertisement break is not part of the video programming but rather outside of the video programming.

In response, Zigmond discloses pausing the program to *insert* a commercial break *into* the displayed video program (column 16, lines 30-44). Zigmond designates where the commercial break should occur and then inserts the required advertising. Thus, applicant's arguments are not persuasive, as Zigmond is *designating* the commercial break *within* the program.

c. On page 10, applicant argues that Zigmond fails to disclose wherein the beginning portion is of a particular length of time.

In response, Zigmond discloses selecting two or more appropriate advertisements and providing them both for selection by the user (column 16, line 65-column 17, line 9). The viewer is given a defined amount of time to make a selection before a default ad is selected for them (column 17, lines 1-9). Thus, the display of the menu at the beginning of the commercial break is clearly of a particular length of time, as the system will display two advertisements and then pause to give the viewer a defined length of time to make a selection. Therefore, applicant's arguments are not convincing.

d. In response to applicant's arguments on pages 12-13, regarding designating a beginning portion and pausing the program segment, see (a) – (c) above.

e. In response to applicant's arguments on page 13, regarding the displaying of a menu, it is noted that Zigmond discloses wherein two or more advertisements are displayed to the viewer (column 16, line 65-column 17, line 9) so as to allow the viewer *to select the advertisement which is of greatest interest* (column 17, lines 3-5). Applicant's arguments are not persuasive, as providing a viewer with a list of *selectable options* on the television screen clearly meets the definition of a "menu".

Election/Restrictions

2. Claims 30-31 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, advertisements with designated content portions. Election was made **without** traverse in the reply filed on 2/23/07.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 14, 16, 18 and 32-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al. (Zigmond) (6,698,020) (of record).

As to claim 1, Zigmond discloses a process for enhancing viewership of television advertisements (Fig. 5, column 1, lines 23-43), comprising:

designating a beginning portion of a commercial break in a program segment (column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is of a particular length of time (wherein the user has a predetermined time to select an ad before a default is chosen; column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is authored to provide a teaser to entice a viewer to watch commercials during the commercial break (column 16, line 65-column 17, line 9) before the viewer causes a digital video recorder (DVR) to skip through the commercial break (provided at the initiation of the commercial break; column 16, lines 30-43 and column 16, line 65-column 17, line 9); and

pausing playing of the program segment, by the DVR, after displaying the teaser (column 16, lines 30-43).

As to claim 2, Zigmond discloses wherein the teaser is a set of images that indicate a commercial relating to a particular advertisement is present (displaying of

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video images corresponding to the particular ad to allow the viewer to determine the ad of greatest interest; column 16, line 65-column 17, line 9).

As to claim 3, Zigmond discloses wherein the teaser is a short sequence of animations (column 16, line 65-column 17, line 9 and column 9, lines 9-20).

As to claim 14, Zigmond discloses wherein the teaser is a menu (column 16, line 65-column 17, line 9) and the viewer is allowed to select a particular item in the menu (column 16, line 65-column 17, line 9).

As to claim 16, Zigmond discloses a process for enhancing viewership of television advertisements (Fig. 5, column 1, lines 23-43), comprising the steps of:

designating a beginning portion of a commercial break in a program segment (column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is of a particular length of time (column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is authored to cause a DVR to display a menu to a viewer (column 16, line 65-column 17, line 9) before the viewer causes the DVR to skip through the commercial break (provided at the initiation of the commercial break; column 16, lines 30-43 and column 16, line 65-column 17, line 9);

pausing playing the program segment, by the DVR, while displaying the teaser (column 16, lines 30-43); and

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wherein the viewer is allowed to select a particular item via the menu (column 16, line 65-column 17, line 9).

As to claim 18, Zigmond disclose wherein the teaser is a tag that triggers the DVR to display a menu (code pausing the program and initiating ad menu display; column 16, lines 30-43 and column 16, line 65-column 17, line 9).

As to claim 32, Zigmond discloses a process for enhancing viewership of television advertisements (Fig. 5, column 1, lines 23-43), comprising:

designating a beginning portion of a commercial break in a program segment (column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is of a particular length of time (wherein the user has a predetermined time to select an ad before a default is chosen; column 16, lines 30-43 and column 16, line 65-column 17, line 9);

wherein the beginning portion is authored to provide a teaser to entice a viewer to watch commercials during the commercial break (column 16, line 65-column 17, line 9); and

pausing playing of the program segment after displaying the teaser (column 16, lines 30-43).

As to claim 33, Zigmond discloses wherein the teaser is a set of images that indicate a commercial relating to a particular advertisement is present (displaying of

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video images corresponding to the particular ad to allow the viewer to determine the ad of greatest interest; column 16, line 65-column 17, line 9).

As to claim 34, Zigmond discloses wherein the teaser is a short sequence of animations (column 16, line 65-column 17, line 9 and column 9, lines 9-20).

As to claim 35, Zigmond discloses wherein the teaser is a menu (column 16, line 65-column 17, line 9) and the viewer is allowed to select a particular item in the menu (column 16, line 65-column 17, line 9).

As to claim 36, Zigmond disclose wherein the teaser is a tag that triggers displaying of a menu (code pausing the program and initiating ad menu display; column 16, lines 30-43 and column 16, line 65-column 17, line 9).

Conclusion

5. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Typed or printed name of person signing this certificate:

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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. () _____ - _____ on _____
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Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sheleheda whose telephone number is (571) 272-7357. The examiner can normally be reached on 9:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Sheleheda
Patent Examiner
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